

Amendment and Response under 37 C.F.R. 1.116

Applicant: Wesley R. Schalk et al.

Serial No.: 10/657,973

Filed: September 9, 2003

Docket No.: 100201968-4

Title: POWER TRANSMISSION ARRANGEMENT

REMARKS

The following Remarks are made in response to the Final Office Action mailed April 10, 2006, in which claims 11-13, 17-21, 24, and 30-35 were allowed, claims 25-29 were rejected, and claim 16 was objected to.

With this Amendment, claim 16 has been amended to correct dependency. Claims 11-13, 16-21, and 24-35, therefore, remain pending in the application and are presented for reconsideration and allowance.

Claim Objections

Claim 16 is objected to as being dependent upon a canceled claim.

With this Amendment, claim 16 has been amended to depend from independent claim 11. Applicant, therefore, respectfully requests that the objection to claim 16 be reconsidered and withdrawn, and that claim 16 be allowed.

Claim Rejections under 35 U.S.C. § 102

Claims 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato US Patent No. 5,697,603. Claims 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. US Patent No. 4,843,903.

Applicant respectfully traverses these rejections.

Independent claim 25 includes "means for selectively engaging and disengaging the pinion gear with the idler gear when the shift plate is rotated between the first position and the second position."

Regarding a "means-or-step-plus-function" limitation, the USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application. See *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). As held in *Donaldson*, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. See *Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850 (stating that 35 U.S.C. 112, sixth paragraph "merely sets a limit on how

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broadly the PTO may construe means-plus-function language under the rubric of reasonable interpretation").

As set forth in MPEP 2181, a claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

Regarding claim 25, Applicant submits that the limitation of "means for selectively engaging and disengaging the pinion gear with the idler gear when the shift plate is rotated between the first position and the second position," as originally filed, properly invokes 35 U.S.C. 112, sixth paragraph.

Accordingly, with respect to the Kato and Tanaka et al. patents, Applicant submits that neither of these patents teach or suggest a power transmission arrangement as claimed in independent claim 25 including "means for selectively engaging and disengaging the pinion gear with the idler gear when the shift plate is rotated between the first position and the second position" as disclosed and described in the specification.

In view of the above, Applicant submits that independent claim 25 is patentably distinct from the Kato and Tanaka et al. patents and, therefore, is in a condition for allowance. Furthermore, as dependent claims 26-29 further define patentably distinct claim 25, Applicant submits that these dependent claims are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejections of claims 25-29 under 35 U.S.C. 102(b) be reconsidered and withdrawn, and that claims 25-29 be allowed.

Allowable Subject Matter

Claims 11-13, 17-21, 24, and 30-35 are allowed. Applicant appreciates the indicated allowance of these claims.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 11-13, 16-21, and 24-35 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Robert D. Wasson at Telephone No. (360) 212-2338, Facsimile No. (360) 212-3060 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 7th day of June, 2006.

By 

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